REMARKS

Claim 40 has been amended to include the features of claim 48, claim 49 has been amended, and claim 48 has been canceled. No new matter has been added, and no further searching should be warranted since claim 48 was previously presented and presumably searched. After entry of the above amendments, claims 40-47 and 49-62 are pending.

Claim Rejection(s) – 35 U.S.C. § 102

Claims 40-62 have been rejected under 35 U.S.C. § 102(g) over the sole lost count of Patent Interference No. 105,406. The lost count recites:

> 143. A method of forming a film of crystalline $YBa_2Cu_3O_7$ comprising:
>
> forming a precursor film comprising barium (Ba), fluorine (F), yttrium (Y) and copper (Cu);
>
> heat-treating said precursor film at a temperature above about 700° C in the presence of oxygen and water vapor at a sub-atmospheric pressure to form a crystalline structure; and
>
> annealing said crystalline structure in the presence of oxygen.

As amended, claim 40, the sole independent claim, recites:

> A method of producing an oriented oxide superconducting film, comprising:
>
> (a) providing a metal oxyflouride film on a substrate, said metal oxyflouride film comprising the constituent metallic elements of an oxide superconductor in substantially stoichiometric proportions;
>
> (b) converting the metal oxyflouride into the oxide superconductor in a processing gas having a total pressure less than atmospheric pressure under conditions that enable the removal of HF from the film surface, and
>
> further comprising depositing a buffer layer on the substrate before step (a).

Amended claims 40-47 and 49-62 are patentably distinct from the subject matter of the sole count. As stated in the MPEP § 802.01(II), "related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is patentable (novel and nonobvious) over the other (though they may each be unpatentable over the prior art)."

Here, claims 40-47 and 49-62 not related to the sole count. For example, claim 40 and the sole count cannot be properly written as an independent claim and as a claim dependent from the independent claim. But even assuming that claims 40-47 and 49-62 and the sole count are related, which they are not, claims 40-47 and 49-62 and the sole count are distinct because the claimed inventions are not connected in at least one operation, namely, deposition of a buffer layer on a substrate before providing a metal oxyflouride film on the substrate. Furthermore, claims 40-47 and 49-62 are patentable over the sole count because nothing in the subject matter of the sole count discloses or suggests depositing a buffer layer on a substrate before providing a metal oxyflouride film on the substrate.

Moreover, the subject matter of amended claims 40-47 and 49-62 is not generic to the subject matter of the sole count. Claims 40-47 and 49-62 require depositing a buffer layer on a substrate before providing a metal oxyflouride film on the substrate. The subject matter of the sole count, on the other hand, does not include any deposition of a buffer layer. The method covered by the sole count can be practiced without ever having to deposit a buffer layer. As a result, claims 40-47 and 49-62 cannot be generic to and do not encompass the subject matter of the sole count.

In light of the above amendments and remarks, claims 40-47 and 49-62 are patentably distinct from and are not generic to the subject matter of the sole count. For at least these reasons, the claims are in condition for allowance, which action is requested.

No fee is believed to be due, but please apply any charges or credits to deposit account 03-1721, referencing Attorney Docket No. 0492611-0545/MIT9277CON2.

Respectfully submitted,

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